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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,758	09/23/2003	Alan Carter	ALC-10002/29	2553

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,758

Applicant(s)

CARTER, ALAN

Examiner

Gary Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spring and required intermediate parts of the mechanism set forth as the invention by claim limitation of "quick release mechanism including a spring-biased pushbutton on the body for releasing the U-shaped hasp of the window" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3, and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure does not adequately illustrate or describe the claimed "quick release mechanism including a spring-biased button on the body for releasing the U-shaped hasp of the window". While a button is shown, the actual invention, ie quick release mechanism required for operation of the claimed invention is not shown or adequately described in such a way that one of ordinary skill in the art would know how to make and use same.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1, 3, and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how to interpret the scope of the invention, particularly the preamble. It is not clear if the preamble sets forth an environment ("vehicle of the type with a window having a U-shaped hasp that engages with a hasp-locking mechanism on the vehicle when the window is closed") wherein the claimed invention ("a device configured to mount,...") might be used, or positively recites the "vehicle,..., window" and "device" all together in combination as the claimed invention. As phrased, one of ordinary skill in the art would most likely assume the *claimed invention is in a vehicle*,... and not taught by a device that is not in a vehicle, but clarification and/or correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,278,280 to Rashbaum.

Assuming the combination including a "a vehicle of the type with a window having a U-shaped hasp that engages with a hasp-locking mechanism on the vehicle" is not claimed as part of the invention, Rashbaum '280 teaches structure that reads on all claim limitations.

As regards claim 3, the bar portion at 50 forms bridgin part of U-shape as it is connected to two sidepieces.

As regards claim 4, the substitute hasp of the refernce is shown to be "curved", ie having a circular cross-section as it is shown in Fig 7.

1. Claims 1, 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,278,280 to Rashbaum in view of U.S. Pat. No. 5,165,742 to Frayne

Rashbaum '280 teaches Applicant's claim limitations including : a "body" – including 13,14,12, a "substitute hasp" – including 50, an "opening" – the opening in the 'hook' described at col 5 line 1, a "quick release mechanism" – including 17. While Rashbaum '280 does not teach use of the device on a window as claimed, Frayne '742 fully discloses a "vehicle or the type with a window having a U-shaped hasp that engages with a hasp-locking mechanism on the vehicle" – as shown on the face of the Patent, and use of a similar device as that of Rashbaum '280 for holding the window in partially open position. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a device as taught by Rashbaum '280 with a vehicle with window as taught by Frayne '742 in order to hold the window partially open as taught by Frayne '742. one of ordinary skill in the art would have more than a reasonable

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expectation of success since the proposed combination would have required little if any modification (possibly a change in size) and would perform analogous function to which it was originally disclosed.

One of ordinary skill in the art would recognize that part 17 can inherently be used for release of 13 from 14. While the arrangement is not identical to the device *disclosed* by Applicant, the structure of the prior art reads on the present claim language. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. See MPEP 2114.

Response to Arguments

2. Applicant's arguments filed with the response have been fully considered but are not entirely persuasive. Arguments that a prima facie case of obviousness was not made in the first Office Action are not persuasive where one of ordinary skill in the art would readily recognize that both devices are in the same art (latches) and intended to be used in a similar manner (to hold a closure in an open position). The proposed modification is not so much a modification of the structure of the base reference, but a modification to the intended use of that device from what has been explicitly disclosed in

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the base reference (ie, on a vehicle's trunk). More particularly, the examiner has proposed that it would have been obvious to one of ordinary skill in the art at the time of the invention to use the device on a window as explicitly taught by the modifying reference which otherwise discloses a device that is similar to that of the base reference and that disclosed in the present Application but is explicitly disclosed for use on window. Contrary to Applicant's arguments, the suggestion and motivation to use a latch device such as that disclosed in the two references and this Application, on a window of a vehicle is explicitly disclosed by the modifying reference, and therefore does explicitly come from the prior art that one of ordinary skill in the art is presumed to be knowledgeable. Otherwise, one of ordinary skill in the art would have more than a reasonable expectation of success since the combination would not otherwise affect the function of the latch of the base reference. Had the base reference explicitly suggested using the device disclosed therein on a window, the rejection would have been made under 35 USC 102.

In any case, claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

Due to new grounds of rejection, this Office Action is not made Final in order to afford Applicant full opportunity to address issues during unlimited stage of prosecution.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 571 272-7055. The examiner can normally be reached on M-Thur 7:30-6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Estremsky
Primary Examiner
Art Unit 3676